

1                   36. (As filed) An aerosolizing apparatus comprising:  
2                   a housing having an exit opening;  
3                   an aerosol generator disposed in the housing, the aerosol generator comprising a  
4 plate body having a front surface, a rear surface, and a plurality of tapered apertures extending  
5 from the rear surface to the front surface, wherein the plate body is constructed primarily of  
6 palladium, and a vibratable element disposed to vibrate the plate body.

1                   37. (Amended) An apparatus as in claim 36, wherein the plate body is  
2 constructed of palladium-nickel.

1                   38. (Amended) An apparatus as in claim 37, wherein the plate body is  
2 constructed of about 80% palladium and about 20% nickel.

1                   39. (Amended) An apparatus as in claim 36, wherein the plate body is  
2 constructed of palladium cobalt.

REMARKS

Claims 32-39 have been examined. Claims 33-35 and 37-39 have been amended. Reconsideration of the claims, as amended, is respectfully requested.

In the Office Action, claims 32-29 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Ivri in view of Dowell. This rejection is improper for it is based solely on the Examiner's own conclusions, rather than on the cited art. Further to Applicants' previous response, the Examiner has failed to explain his basis for concluding that the cited prior art suggests the combination the Examiner asserts to be obvious.

As set forth in the MPEP, in order to establish a prima facie case of obviousness all of the claimed elements must be taught or suggested by the combination of references. MPEP 2142. The rejection set forth in the Office Action clearly fails to meet this standard and does therefore not establish a prima facie case of obviousness for this additional reason.

More specifically, independent claims 32 and 36 each include the limitation of a plate body having a plurality of apertures that is constructed primarily of palladium. In contrast, the Office Action recognizes that Ivri does not disclose the use of palladium by reciting that "the specifically claimed materials of the plate are not disclosed." Similarly, nowhere in Dowell is the use of palladium mentioned. Hence, even if combined, these references do not teach or suggest the claimed limitations. Hence, a prima facie case of obviousness has not been established by the cited references.

In order to correct this defect, the Office Action recites that "it would also have been obvious to have used any of the claimed materials (palladium/palladium alloys) as these would simply have been obvious known alternatives to gold." However, an "obvious to try" standard is clearly not the standard for patentability. Absent some teaching in the prior art of using palladium to construct an aperture plate, a prima facie case of obviousness has not been established. A bald statement that "any of the claimed materials . . . would have been obvious" in view of Applicants own disclosure (which is clearly not an admission of prior art, but merely describes various alternative embodiments) is simply not warranted by existing law. Indeed, the Office Action is relying only upon Applicants' own disclosure of the use of palladium to reject claims 32-39 that claim such a feature. Since this is clearly not the standard for patentability, it is respectfully requested that the §103 rejection of claims 32-39 be withdrawn.

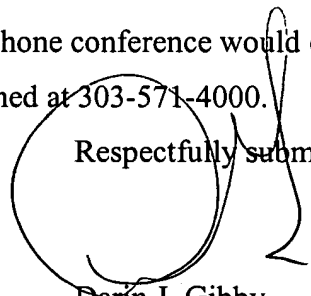
Moreover, as set forth in Applicants' previous response, such a rejection is merely a combination of elements from non-analogous sources that have been combined based upon teachings in Applicants' own disclosure. Such a combination is clearly impermissible under well established law. See In re Oetiker, 977 F2d 1442 (Fed. Cir. 1992). Hence, for this additional reason it is respectfully requested that the section 103 rejection of claims 32-39 be withdrawn.

#### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

  
Darin J. Gibby  
Reg. No. 38,464

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, California 94111-3834  
Tel: (303) 571-4000  
Fax: (303) 571-4321  
DJG/cl  
DE 7043034 v1

**Marked Claims Pursuant to 37 CFR § 1.121(c)**

- 1 32. (As filed) A vibratable aperture plate, comprising:  
2 a plate body having a front surface, a rear surface, and a plurality of tapered  
3 apertures extending from the rear surface to the front surface, wherein the plate body is  
4 constructed primarily of palladium.
- 1 33. (Amended) An aperture plate as in claim [1], 32 wherein the plate body is  
2 constructed of palladium-nickel.
- 1 34. (Amended) An aperture plate as in claim [2] 33, wherein the plate body is  
2 constructed of about 80% palladium and about 20% nickel.
- 1 35. (Amended) An aperture plate as in claim [1] 32, wherein the plate body is  
2 constructed of palladium cobalt.
- 1 36. (As filed) An aerosolizing apparatus comprising:  
2 a housing having an exit opening;  
3 an aerosol generator disposed in the housing, the aerosol generator comprising a  
4 plate body having a front surface, a rear surface, and a plurality of tapered apertures extending  
5 from the rear surface to the front surface, wherein the plate body is constructed primarily of  
6 palladium, and a vibratable element disposed to vibrate the plate body.
- 1 37. (Amended) An apparatus as in claim [5], 36 wherein the plate body is  
2 constructed of palladium-nickel.
- 1 38. (Amended) An apparatus as in claim [6] 37, wherein the plate body is  
2 constructed of about 80% palladium and about 20% nickel.
- 1 39. (Amended) An apparatus as in claim [5] 36, wherein the plate body is  
2 constructed of palladium cobalt.